

### **REMARKS**

The Official Action of May 4, 2010 constitutes a final rejection of the claims. The Action and the references cited therein have been carefully reviewed. Favorable reconsideration and allowance of the claims are requested.

#### **I. Claim Status and Amendments**

Claims 1, 3-13, 15-17, 20-22, 24, 25, and 28-31 are pending in this application. Claims 1 and 3-13 have been withdrawn as non-elected subject matter. Claims 15-17, 20-22, 24, 25, and 28-31 have been examined on the merits and stand rejected. No claims have been allowed.

By way of the present amendment, claim 15 has been amended, in a non-narrowing manner, to make minor, editorial and grammatical changes to better conform to US claim form and practice. Accordingly, there is no reason to deny entry of this amendment. No new matter has been added.

The pending claims define patentable subject matter warranting their allowance for the reasons discussed herein.

#### **II. Prior Art Rejections**

Claims 15, 16, 20, 22 and 28 and new claims 29 and 30 have been rejected under 35 USC §103(a) as being unpatentable over Taranta (US 2002/0098221) in view of Aven (US 6,165,940). This rejection is respectfully traversed for the reasons of record, repeated respectfully by reference from

the preceding reply, and for the additional reasons set forth below.

Claims 17, 21, 24 and 25 and new claim 31 have been rejected as obvious under §103 from Taranta in view of Aven and further in view of Lubetzky (EP 6070113). The rejection also refers to another Lubetzky et al "US 0670113", but there appears to be no such document. The rejection is respectfully traversed for reasons of record, respectfully repeated by reference, and for the reasons set forth below.

The rejections are respectfully traversed and will be discussed together below, since Taranta and Aven are used in each rejection.

On pages 2-4 of the Office Action, the examiner replies to Applicants' arguments (referred to by the examiner as (A), (B), and (C)) in the last response and provides reasons for maintaining the rejections.

Regarding (A), the examiner previously argued that the number of monocarboxylic esters disclosed in Taranta is quite limited and it would have been obvious to try any one of these from this finite number of esters with a reasonable chance of success to arrive at Applicants' lactates. In reply, Applicants argued that, contrary to the examiner's position, the number of possibilities of compounds which fall within the Taranta composition is truly immense. This position is

reiterated herein. As previously noted, the abstract and claims of Taranta say the composition is to comprise an ester of an aliphatic monocarboxylic acid **or** an ester of an aliphatic dicarboxylic acid **or** an ester of aromatic monocarboxylic acid, esters of aromatic dicarboxylic and tri-n-alkylphosphates. Consequently, the number of possibilities of compounds which fall within the Taranta composition is truly immense.

Further, the listing of monocarboxylic acids in paragraph [0032] includes both specific and generic designations, in which the generic designations themselves include large numbers of unspecified possibilities. From counting just the designations in paragraph [0032] alone, there are at least forty (40) different possibilities. It is again respectfully submitted that this cannot be validly characterized as a limited number of finite possibilities, as argued by the examiner.

Moreover, there are even further possibilities given in paragraphs [0033] to [0036] and paragraphs [0038] to [0040] of Taranta. Again, the list of possibilities from which a selection must be made to reach Applicants' lactates from Taranta is truly immense.

Nonetheless, the examiner still contends that Taranta requires picking one or more solvents from the group

of esters of aliphatic monocarboxylic acids, esters of aliphatic dicarboxylic acids, esters of aromatic monocarboxylic acids, esters of aromatic dicarboxylic acids and tri-n-alkylphosphates, and that selecting a species from that group would be limited.

Applicants again respectfully disagree for reasons of record, which are reiterated herein and for the following reasons.

First, why would the skilled artisan, even upon reading Taranta, opt to make a pesticidal formulation, as claimed, wherein the solvent is comprised of an ester of aliphatic monocarboxylic acids? More specifically, why would the skilled artisan select lactate esters from the group of ester of aliphatic monocarboxylic acids? There is simply no rationale or suggestion in Taranta to do so. In fact, the examiner seemingly contradicts himself at paragraphs 13 and 14 on page 5 of the Official Action. In this regard, at paragraph 13, the examiner states that exemplified compounds are: ethylhexyl lactate, butyl lactate, ethyl lactate, which are lactate esters. Yet, at paragraph 14, the examiner states that "Taranta fails to specifically teach a composition that comprises a lactate ester." Applicants agree that Taranta does not disclose a composition that comprises a lactate ester, and thus, Taranta does not contemplate the use of a

lactate ester together with another compound, let alone a fungicide, in a composition.

It is acknowledged that Taranta lists examples of solvents on [0032] to [0036] *inter alia* the lactate esters, however, it is again noted that Taranta does not provide examples using these solvents. Nor does Taranta provide a suggestion for doing so. Again, why would a person skilled in the art select the lactate esters?

In the absence of specific examples showing the beneficial effect of a similar claimed composition, the lists of solvents do not provide any direction or guidance as to which solvents would be suitable to use.

Second, it is again noted that main claim 15 recites that the "composition is substantially free of fungicide crystals". Yet, how can the skilled artisan predict that an ester of aliphatic monocarboxylic acid, specifically lactate esters as claimed, would be suitable for preventing the crystallization of the fungicides claimed, when diluted with water, as claimed? Again, Taranta does not disclose or suggest this; Taranta does not contemplate the use of a lactate ester with another compound in a composition. There is no teaching or suggestion of this in the cited references. In the absence of guidance and specific examples, there is no teaching that lactate esters are solvents useful for

solubilizing fungicides, and preventing their crystallization when diluted with water, as claimed.

All of this is evidence as to why the skilled artisan could not reasonably select Applicants' lactates from the immense list of possibilities from which a selection must be made in Taranta in order to arrive at the claimed invention. It points to the non-obviousness of the claims.

Regarding (B), Applicants previously argued that the ester solvents of Taranta appear in a huge "basket" or "shotgun" disclosure, with no teaching or suggestion in Taranta or in the rejection itself leading the skilled artisan to select only lactate esters from the huge basket or shotgun disclosures, and consequently Taranta does not lead the skilled artisan to the selection of any lactate esters. Again, this point cannot be validly denied, as the listing of hundreds and possibly thousands of possibilities does not lead one to select what the present invention requires. Again, the basket or shotgun disclosure of Taranta is akin to presenting a person with the face of a combination lock and expecting that person to figure out the combination. Yet, neither Taranta nor Aven provide any reason for selecting a lactate from among the many hundreds or more possibilities listed by Taranta.

Applicants again ask why would the skilled artisan use an ester of an aliphatic monocarboxylic acid?

Even if esters of aliphatic monocarboxylic acids are selected, it should be noted that paragraphs [0032] to [0036] include a list of many solvents, and why would the skilled artisan select lactate esters from this list of solvents? Again, there is no teaching or suggestion to do so.

Applicants again respectfully submit that contrary to the examiner's position this is not a situation where it would have been obvious to try choosing from a finite number of identified, predictable solvents, with a reasonable expectation of success. The number of possibilities is not limited, but rather the number is immense. Further, Applicants' results are not at all predictable because Taranta provides not the remotest hint of the results from the use of lactates, let alone to do so to prevent crystallization. As such, it cannot be validly stated that there would be a reasonable expectation of attaining Applicants' success, as again Taranta does not indicate that a different type of success (prevention of crystallization) will result from the selection of lactate esters from among the many hundreds or even thousands of possibilities set forth by Taranta.

Regarding (C), Applicants again respectfully submit that Taranta teaches away from the claimed invention. Paragraph [0041] of Taranta says that it is preferred to use two or more solvents, not at all necessary according to the present invention; and in paragraph [0042] that it is particularly advantageous, when the active substance is not very soluble, to incorporate one or more polar co-solvents. In paragraphs [0043] and [0044], Taranta suggests the use of ketones, alcohols, etc. as appropriate polar co-solvents, all different from the lactate esters according to the present invention. And finally, in paragraph [0045], Taranta mentions for the first time that the polar co-solvent is used "to avoid crystallization during the dilution before application." This means that the only solution given by Taranta to avoid crystallization is to use the polar co-solvents disclosed in Taranta, which leads away from the claimed invention, since Taranta does not teach lactate esters as essential component in the present invention for avoiding crystallization. It is therefore fair to say that in order to achieve or insure Applicant's results of crystal inhibition, Taranta requires the use of a polar co-solvent, i.e. an added ingredient which is different from the lactate esters according to the present invention and which appears in the list of solvents (not co-solvents) in Taranta. Thus, the present invention



specifically teaches lactate esters as essential components to avoid crystallization, a feature not disclosed in Taranta in connection with avoiding crystallization of the claimed fungicides. This is another reason why Applicants' claims define non-obvious subject matter.

Nevertheless, the claimed invention does not exclude the use of extra solvents.

It is again pointed out that when the prior art provides many hundreds or even thousands of possibilities, as is the case here, the skilled artisan would look elsewhere for better guidance, and that "elsewhere" is in the examples of Taranta. To not do so, makes no sense at all, because to not look at the specific examples of Taranta, would require the skilled artisan to start testing each and every one of the hundreds and even thousands of the possibilities of esters set forth in paragraphs [0033] through [0040] of Taranta. This is illogical. Instead, the logical and therefore the obvious way to proceed is to begin with the much more specific disclosure of Taranta's examples where six different solvents were used, and those examples lead away from the present invention.

Yet, the examiner replies that the present claims do not exclude the use of extra solvents, such as co-solvents, as required by Taranta. However, this position ignores the fact that Taranta's teaching of the need for polar co-solvents to

prevent crystallization, and in particular, the specific ones used in the examples of Taranta, teaches away from the use of lactate esters altogether, since Taranta himself does not use or suggest lactate esters as the polar co-solvents. Thus, it should not matter that Applicants' do not exclude the possibility of ingredients.

Also, the examiner, at the top of page 4, argues that prevention of crystallization is a benefit of including lactate esters into the fungicidal composition. However, Taranta does not teach this. Instead, as discussed above, Taranta discloses that polar co-solvents are needed. Taranta never discloses that lactate esters should be used to achieve this purpose.

It is again respectfully submitted that it could not have been predicted or foreseen from the prior art, i.e. "a person of ordinary skill would not have had the expectation" that lactate esters would provide the benefit of substantially eliminating crystallization for the claimed fungicides (which exhibit a high tendency toward crystallization when diluted with water). The claimed invention is not a property of an otherwise known composition since the combination of active ingredients and solvent has not been disclosed before.

For these reasons, it should be clear that the choices of acid esters provided by Taranta amount to the many

hundreds, and possibly thousands. Applicants' selection was unobvious, and Applicants' results could not have been reasonably expected.

At the very least, Taranta mentions nothing about the amount of lactate ester (3 to 80%) to be used of claim 20 or the weight ratio between the fungicide and the lactate ester is from 1:0.2 to 1:5 of claim 22 or 1:1 to 1:4 of claim 28. Nor does Taranta disclose or suggest the composition of claim 17 comprising 20% to 60% of a lactate ester selected from the group consisting of 2-ethyl hexyl lactate, cyclohexyl lactate, 2-methylcyclohexyl lactate, heptyl lactate, octyl lactate and mixtures thereof, and 1% to 10 % of rosin gum.

The secondary reference of Aven fails to remedy the above-noted deficiencies in Taranta. In this regard, Aven has been cited for a purpose entirely unrelated to the discussion presented above. Thus, even if it were obvious to modify Taranta by what is suggested by Aven, which does not make up for the aforementioned deficiencies of Taranta, the resultant reconstructed Taranta would not reach any of Applicants' claims.

Further, it is respectfully submitted that the skilled artisan would not have any reason to use the teaching of Taranta and Aven to replace the insecticides of Taranta by the fungicides of Aven and to select lactate esters as a

solvent from the wide list of solvents. Arriving at such composition would require major alteration of the composition.

For these reasons, withdrawal of the obviousness rejection over Taranta and Aven is in order and is respectfully requested.

Lastly, Applicants respectfully traverse the obviousness rejection of claims 17, 21, 24, 25, and 31 over Taranta and Aven and further in view of Lubetzky for the same reasons set forth above and in the last response.

Claims 17, 21, 24 and 25 depend ultimately from claim 15 and thus incorporate the subject matter of claim 15. It has been pointed out above that claim 15 defines non-obvious subject matter over Taranta in view of Aven.

Lubetzky has been cited only for its disclosure of the use of a rosin component. Lubetzky does not cure any of the deficiencies noted above. Therefore, even if the proposed combination were obvious, the so-reconstructed Taranta would not reach even claim 15, let alone claims 17, 21, 24, 25, and 31.

Withdrawal of the rejection over Taranta, Aven, and Lubetzky is in order and is respectfully requested.

### **III. Conclusion**

Having addressed all the outstanding issues, this paper is believed to be fully responsive to the Office Action. It is respectfully submitted that the claims are in condition for allowance, and favorable action thereon is requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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